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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,307	07/18/2003	Roger Rioux	100RRDRMW	2516
7590	09/23/2004		EXAMINER	
ROGER RIOUX 1 HORIZON ROAD APT. 1016 FORT LEE, NY 07024			CHIU, RALEIGH W	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/621,307	RIOUX ET AL.
Examiner	Art Unit	
Raleigh Chiu	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 18 July 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>07/18/2003</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

**DETAILED ACTION**

***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the alleged method steps must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. That is to say, method steps may be illustrated by an appropriate flow chart or a series of pictures showing the steps in sequence; if the claims are to encompass method steps, the process steps must be shown.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of

the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the specification does not discuss how a player's hands are positioned slightly forward of the golf ball during the alignment process as set forth in claim 3.

3. The disclosure is objected to because of the following informalities: the well is not considered to be self-aligning when operator adjustments are necessary.

Appropriate correction is required.

***Claim Objections***

4. The claims are objected to because the lines are crowded too closely together, making reading and entry of amendments

difficult. Substitute claims with lines one and one-half or double spaced on good quality paper are required. See 37 CFR 1.52(b).

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is not clear how a well can be considered to be self-centering when an operator may be required to adjust the position of the golf club head to center it within the well.

8. Claims 1-3 provide for the use of marking and aligning golf club heads and golf balls; and the use of measuring a golf club face center, but, since the claims do not set forth any steps involved in the method/process, it is unclear what methods/processes applicants are intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

***Claim Rejections - 35 USC § 101***

9. Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication Number 2003/0013538 (Daniels).

Insofar as the scope of the claim can be ascertained, Figure 3 of Daniels shows the use of bands 100,102 to secure a golf club head so that the center line of the club can be measured. Although Daniels only shows a base 42 and not a well, it would have been an obvious matter of design choice to use a

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well since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. Moreover, since the Daniels golf club head is securely fastened to the base with bands 100,102, it appears that the center line of the club head would be able to be measured with a base having any shape.

13. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,422,949 (Byrne *et al.*, hereinafter Byrne).

Insofar as the scope of the claim can be ascertained, Figures 1 and 10 of Byrne show a golf club head and ball with the recited rectangular marks 52,30 that are used for club/ball alignment.

#### **Conclusion**

14. If applicants decide to continue prosecution of this application there are a number of **requirements** and an additional number of further **options**.

a. Applicants are required to:

- i. request reconsideration;
- ii. respond to every ground of rejection and objection noted in this action; and,

iii. argue the patentability of each claim by pointing out how it is not considered to be indefinite and how it avoids the prior art when applied alone or in combination against it. 37 CFR 1.111(b).

b. Applicants are allowed to, among other things:

i. request that the correction of formal matters be held in abeyance until allowable subject matter has been indicated (if this action includes an indication of allowable subject matter, such as by including a suggested claim, applicants must correct all formal matters);

ii. amend any or all of the present claims (see 37 CFR 1.121 for procedures for amending claims);

iii. cancel any or all of the present claims; and,

iv. add one or more new claims (if the number of claims - total and/or independent - remaining in this case after a response is entered will exceed the number previously paid for, an additional fee will be required and such additional fee must accompany the response).

15. The following claim, drafted by the examiner and considered to distinguish patentably over the art of record in this application, is presented to applicants for consideration:

4. (New) A method of marking and aligning golf club heads and golf balls, comprising the steps of:

providing a body containing a first well to accommodate golf club heads of various heights and widths, said well containing a wall having an arc to accommodate the golf club head when placed within said well;

providing a golf club head centering band attached to said body, said centering band having a central portion removed which provides an opening and access to the top surface of said golf club head;

securing said golf club head within said well by placing said golf club head centering band over the dorsal surface of said golf club head;

providing an adjustable arm to said body to provide support for a golf club shaft;

providing a second well in said body to accommodate a golf ball and in axial alignment with said first well;

providing a golf ball cover adapted to enclose said golf ball, said golf ball cover having a window of equal width as said opening of said centering band;

providing indicia to said golf ball and said golf club head as a means of identification and alignment of said golf ball and said golf club head during play, said indicia being one of: shapes, lines, marks, labels, pictures and symbols.

16. If applicants decide to accept the suggested claim, they must present it in an amendment. If applicants also cancel all the rejected claims and present no additional new claims, this application will be in condition for allowance on its merits (based on the record at this time), but may still be subject to correction of formal matters. If applicants accept the suggested claim they should also carefully review the specification, and amend it as necessary, to assure that there is adequate support in the description for the terms and phrases used in the claims, and review the drawings to assure every feature claimed is shown therein.

17. In accordance with 1173 OG 13, any response to this Office action should be addressed to:

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Any appropriate Special Box designation as currently listed in each issue of the *Official Gazette* should also be used. Note also 37 CFR 1.2.

**1.2 Business to be transacted in writing.**  
All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

18. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under the Rules. Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for response. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

**Certificate of Mailing**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

on \_\_\_\_\_  
(Date)

Typed or printed name of person signing this certificate:

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Signature: \_\_\_\_\_

**Certificate of Transmission**

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) \_\_\_\_\_ - \_\_\_\_\_  
on \_\_\_\_\_  
(Date)

Typed or printed name of person signing this certificate:

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Signature: \_\_\_\_\_

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

19. It would be of great assistance to the Office if all incoming papers pertaining to a filed application carried the following items:

- a. Application number (checked for accuracy, including series code and serial number).
- b. Group art unit number (copied from most recent Office communication).
- c. Filing date.
- d. Name of the examiner who prepared the most recent Office action.
- e. Title of invention.

20. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners". MPEP § 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Technology Center 3700 Customer Service at (703) 308-5648 or CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raleigh Chiu whose telephone number is (703) 308-2247. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich, can be reached on (703) 308-1513.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Other helpful telephone numbers are listed for applicants' benefit.

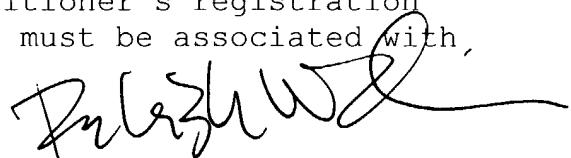
Allowed Files and Publication	(703) 305-8497
Assignment Branch	(703) 308-9723
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Information Help Line	(800) 786-9199
Internet PTO-Home Page	<u>www.uspto.gov</u>

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The Office has ceased mailing paper copies of U.S. patent references with Office actions. See 1282 Off. Gaz. Pat. Office 109 (18 May 2004). Paper copies of foreign patents and non-patent literature will continue to be included with Office actions as well as U.S. patent references cited during the international stage of an international application.

U.S. patent references will continue to be available on the USPTO web site, from the Office of Public Records and from commercial sources.

Practitioners and *pro se* applicants may download U.S. patent references cited in Office actions using the E-Patent Reference feature of private PAIR. For a practitioner or a *pro se* applicant to be able to access private PAIR, the correspondence address of the application must be associated with a customer number, and the practitioner's registration number or the *pro se* applicant's name must be associated with that customer number.



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